

III. Objection to the Specification

In order to remove the alleged informalities identified by the Office, Applicants have amended the specification to include the status of the copending and parent applications referenced in the specification. Copies of the Official Filing Receipts of copending Application Nos. 09/620,523, 09/620,524, and 09/620,526 are enclosed for the Office's convenience. Applicants submit that no new matter has been added by this amendment to the specification. Accordingly, the Office is respectfully requested to withdraw the objection to the disclosure.

IV. Rejection Under 35 U.S.C. §112, first paragraph

The Office has rejected claims 1-63 under 35 U.S.C. § 112, first paragraph, because the specification "does not reasonably provide enablement for unexpected or superior results when any inorganic particle having a thermal conductivity of at least 1 Watt per meter K." Office Action at page 3.

Applicants respectfully traverse this rejection because they are not aware of any authority that requires the specification to provide evidence "for unexpected or superior results." Rather, Applicants respectfully submit the test of enablement is whether one skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d at 1404 (Fed. Cir., 1988).

Indeed, "[a] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented **must** be taken

as in compliance with the enabling requirement of the first paragraph of Section 112 **unless** there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support." *In re Brana*, 34 U.S.P.Q.2d 1436, 1441 (Fed. Cir. 1995) (quoting *In re Marzocchi*, 169 U.S.P.Q. 367, 369 (C.C.P.A. 1971)); *Ex parte Bhide*, 42 U.S.P.Q.2d 1441, 1448 (Bd. Pat. App. Int. 1996). Only after the Office provides **evidence** showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence to convince such a person of the invention's asserted utility. *See Brana* at 1441 (Emphasis added).

The MPEP, citing Federal Circuit law, is very specific with regard to the procedures Examiners must follow in order to establish whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement. A number of factors must be considered when making such a determination. These factors include:

- (A) The breadth of the claims
- (B) The nature of the invention
- (C) The state of the prior art
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

These are known as the *Wands* factors, enunciated by the Federal Circuit in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). With regard to considering these factors, the MPEP is explicit:

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or

more of the others. **The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole.**

MPEP § 2164(a) (citing *In re Wands*, 8 USPQ2d at 1413) (emphasis added).

Applicants respectfully submit that the Office has failed to perform the analysis required by the MPEP and the Federal Circuit, and therefore has not met its burden of supplying evidence to support a determination that a disclosure does not satisfy the enablement requirement. Moreover, Applicants submit the required analysis described above will lead to the conclusion that the specification is enabled for all inorganic particles within the scope of the presently claimed invention.

Applicants also respectfully submit that a rejection based on lack of enablement for “an inorganic particle having a thermal conductivity of at least 1 Watt per meter K” is not proper to claims 33-59 and 61-63, which are included in this rejection yet do not recite this limitation.

Applicants therefore respectfully request this rejection be withdrawn.

V. Rejections Under 35 U.S.C. § 102(b)

Independent claim 1 is directed to a fabric comprising at least one strand comprising a plurality of fibers and having a resin compatible coating composition on at least a portion of a surface of the fabric, the resin compatible coating composition comprising a plurality of discrete particles formed from materials selected from non-heat expandable organic materials, inorganic polymeric materials, lamellar particles having a

thermal conductivity of at least 1 Watt per meter K at a temperature of 300 K, non-heat expandable composite materials and mixtures of any of the foregoing. The coating composition also comprises at least one lubricious material different from the plurality of discrete particles, and at least one film-forming material.

Independent claim 33 is directed to a fabric comprising at least one strand comprising a plurality of fibers and having a resin compatible coating composition on at least a portion of a surface of the fabric. The resin compatible coating composition comprises a plurality of particles comprising: (i) at least one particle formed from at least one organic material, and (ii) at least one particle formed from at least one inorganic material selected from boron nitride, graphite and metal dichalcogenides. The coating composition also comprises at least one lubricious material different from the plurality of discrete particles, and at least one film-forming material.

Independent claim 44 is directed to a fabric comprising at least one strand comprising a plurality of fibers and having a resin compatible coating composition on at least a portion of a surface of the fabric. The resin compatible coating has a loss on ignition of ranging from 0.1 to 1.6, and an air permeability, measured according to ASTM D 737, of no greater than 10 standard cubic feet per minute per square foot.

A. *Terpay*

The Office rejected claims 1-63 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,282,011 to *Terpay* (herein referred to as *Terpay*). The Office contends that *Terpay* "discloses a coating composition comprising a plurality of discrete particles, at least one lubricious material, and at

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least one film-forming material," and further contends that these components "are of the type contemplated by applicants." Office Action at page 4. Applicants respectfully disagree.

A rejection under § 102 is only proper when the claimed subject matter, in this case a fabric, is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); see also M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."). In order to identically describe or disclose the claimed composition, the reference must direct those skilled in the art to the composition without any need for picking, choosing, and combining various disclosures in the reference not directly related to each other by the teachings of the cited reference. *Arkley*, at 587.

Terpay discloses a fabric which may be coated with an adhesive containing abrasive particles. See, e.g., claim 12. Applicants respectfully submit that the Office has failed to show how the fabric recited in independent claims 1, 33, and 44 is identically described or disclosed in the prior art. For example, the Office has not shown how the particles disclosed in *Terpay* fall within the scope of particles recited in claim 1. Additionally, the Office has not shown how *Terpay*'s particles fall within the recitation of (i) one organic material, and (ii) at least one particle formed from at least one inorganic material selected from boron nitride, graphite and metal dichalcogenides, as recited in claim 33. Furthermore, the Office has not shown how *Terpay* identically describes or discloses the at least one lubricious material recited in claims 1 and 33. Finally, the Office has not shown how *Terpay* identically describes or discloses the resin compatible coating composition recited in claim 44.

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In contrast to the Office's position, Applicants submit that a careful reading of *Terpay* will show that this reference fails to identically describe or disclose the fabric recited in independent claims 1, 33, and 44. For example, nothing in *Terpay* identically describes or discloses the resin compatible coating composition recited in independent claim 1 comprising, *inter alia*, the plurality of discrete particles as defined in the claim, and the at least one lubricious material different from the plurality of discrete particles. Similarly, nothing in *Terpay* identically describes or discloses the resin compatible coating composition recited in independent claim 33 comprising, *inter alia*, the plurality of particles as defined in the claim, and the at least one lubricious material different from the plurality of discrete particles. Finally, nothing in *Terpay* identically describes or discloses the resin compatible coating composition recited in independent claim 44. Accordingly, Applicant respectfully requests withdrawal of this rejection.

B. LaCasse

The Office rejected claims 1-63 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,217,778 to LaCasse (herein referred to as *LaCasse*). The Office contends that *LaCasse* "discloses a coating composition comprising a plurality of discrete particles , at least one lubricious material, and at least one film-forming material," and further contends that these components "are of the type contemplated by applicants." Office Action at page 4. Applicants respectfully disagree.

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LaCasse is directed to a dry clutch prepared from a composite of fiber yarns bonded together with a binder system comprising "friction particles" See Abstract. In an argument similar to that in the previous section, Applicants respectfully submit that the Office has failed to show how the fabric recited in independent claims 1, 33, and 44 is identically described or disclosed in the prior art. As above, the Office has not shown how the particles disclosed in *LaCasse* fall within the scope of particles recited in claims 1 and 33. Furthermore, the Office has not shown how *LaCasse* identically describes or discloses the at least one lubricious material recited in claims 1 and 33. Finally, the Office has not shown how *LaCasse* identically describes or discloses the resin compatible coating composition recited in claim 44. Nor do Applicants believe that *LaCasse* identically describes or discloses the fabric recited in independent claims 1, 33, and 44.

Accordingly, Applicant respectfully requests withdrawal of this rejection.

VI. Information Disclosure Statement

A Supplemental Information Disclosure Statement under 37 C.F.R. § 1.97(c) was filed on October 15, 2001. Applicants request that the documents listed therein be considered by the Office, and made of record in this application.

CONCLUSION

Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and
charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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On page 1, substitute the paragraph which starts on line 6 with the following paragraph:

This patent application is a continuing application of U.S. Patent Application Serial No. [09/668,916] **09/568,916** of Novich et al. entitled "Impregnated Glass Fiber Strands and Products Including the Same", filed May 11, 2000, **now abandoned**, which is a continuing application of U.S. Patent Application Serial No. 09/548,379 of B. Novich et al. entitled "Impregnated Glass Fiber Strands and Products Including the Same", filed April 12, 2000, **now abandoned**, which is a continuing application of U.S. Patent Application Serial No. 09/527,034 of Novich et al. entitled "Impregnated Glass Fiber Strands and Products Including the Same", filed March 16, 2000, **now abandoned**, which is (a) a continuation-in-part of International Application PCT/US99/21443 of B. Novich et al. entitled "Glass Fiber-Reinforced Prepregs, Laminates, Electronic Circuit Boards and Methods for Assembling Fabric", with an international filing date of October 8, 1999, which is a continuation-in-part of U.S. Patent Application Serial No. 09/170,578 of B. Novich et al. entitled "Glass Fiber-Reinforced Laminates, Electronic Circuit Boards and Methods for Assembling a Fabric", filed October 13, 1998, **now abandoned**, which is a continuation-in-part of U.S. Patent Application Serial No. 09/130,270 of B. Novich et al. entitled "Glass Fiber-Reinforced Laminates, Electronic Circuit Boards and Methods for Assembling a Fabric", filed August 6, 1998, now abandoned, which is a continuation-in-part application of U.S. Serial No. 09/034,525 of B. Novich et al. entitled "Inorganic Lubricant-Coated Glass Fiber Strands and Products Including the Same" filed March 3, 1998, now abandoned; (b) also a continuation-in-part of U.S. Patent Application Serial No. 09/170,780 of B. Novich et al. entitled "Inorganic Lubricant-Coated Glass Fiber

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Strands and Products Including the Same" filed October 13, 1998, now abandoned, which is a continuation-in-part application of U.S. Patent Application Serial No. 09/034,525 of B. Novich et al. entitled "Inorganic Lubricant-Coated Glass Fiber Strands and Products Including the Same" filed March 3, 1998, now abandoned; (c) also a continuation-in-part of U.S. Patent Application Serial No. 09/170,781 of B. Novich et al. entitled "Glass Fiber Strands Coated With Thermally Conductive Inorganic Solid Particles and Products Including the Same" filed October 13, 1998, now abandoned, which is a continuation-in-part application of U.S. Application Serial No. 09/034,663 filed March 3, 1998, now abandoned; (d) also a continuation-in-part of U.S. Patent Application Serial No. 09/170,579 of B. Novich et al. entitled "Methods for Inhibiting Abrasive Wear of Glass Fiber Strands" filed October 13, 1998, now abandoned, which is a continuation-in-part application of U.S. Patent Application Serial No. 09/034,078 filed March 3, 1998, now abandoned; (e) also a continuation-in-part of International Application PCT/US99/21442 to B. Novich et al. entitled "Impregnated Glass Fiber Strands and Products Including the Same", with an international filing date of October 8, 1999, which is a continuation-in-part of U.S. Patent Application Serial No. 09/170,566 of B. Novich et al. entitled "Impregnated Glass Fiber Strands and Products Including the Same" filed October 13, 1998, now abandoned, which is a continuation-in-part application of U.S. Patent Application Serial No. 09/034,077 filed March 3, 1998, now abandoned; and (f) also a continuation-in-part of U.S. Patent Application Serial No. 09/170,565 of B. Novich et al. entitled "Inorganic Particle-Coated Glass Fiber Strands and Products Including the Same" filed October 13, 1998, now abandoned, which is a

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continuation-in-part application of U.S. Patent Application Serial No. 09/034,056 filed March 3, 1998, now abandoned.

On page 2, substitute the paragraph which starts on line 16 with the following paragraph:

This application is related to U.S. Patent Application Serial No. 09/620,523 of B. Novich et al. entitled "Inorganic Particle-Coated Glass Fiber Strands and Products Including the Same" filed [same date as instant application] July 20, 2000, now pending, U.S. Patent Application Serial No. 09/620,524 of B. Novich et al. entitled "Inorganic Particle-Coated Glass Fiber Strands and Products Including the Same" filed [same date as instant application] July 20, 2000, now pending, and U.S. Patent Application Serial No. 09/620,526 of B. Novich et al. entitled "Inorganic Particle-Coated Glass Fiber Strands and Products Including the Same" filed [same date as instant application] July 20, 2000, now pending.

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